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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,983	08/08/2006	Helge-Ruben Halse	007831.00004	8549
28827 7590 11/07/2008				
GABLE & GOTWALS				
100 WEST FIFTH STREET, 10TH FLOOR				
TULSA, OK 74103				
EXAMINER				
SHAKERI, HADI				
ART UNIT		PAPER NUMBER		
3727				
MAIL DATE		DELIVERY MODE		
11/07/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/578,983

**Applicant(s)**

HALSE, HELGE-RUBEN

**Examiner**

HADI SHAKERI

**Art Unit**

3727

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the weight compensation cylinder (claim 15), lifting device (claim 16) and pipe thread cleaning and lubrication equipment (claim 17) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

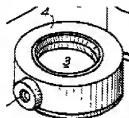
3. Claims 18-20 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 18 recites the limitation "each of the group of clamps" in 1. There is insufficient antecedent basis for this limitation in the claim. Parent claim 1 recites only one group, i.e., "a group" in line 6, rendering the language as recited unclear, further it is noted that the group recited already includes a plurality of clamps, rendering the claim indefinite.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-3, 6, 7, 14 and 18-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al (2,923,192).

Montgomery et al. meets all of the limitations of the above claims in prior Office actions, including new claims 18-20, Montgomery et al. as modified meets the limitations as best

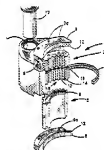
understood, i.e., a plurality of clamps **16**, each actuated with a hydraulic cylinder and piston **15**. With regards to the new claim 14, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use more than one motor,



to increase the output depending on the application, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

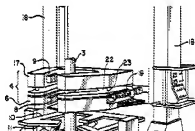
7. Claim 6 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al as applied to claim 1 above, and further in view of Buck (6,253,643).

Montgomery et al modified by Buck as described in the previous Office action meets all of the limitations of the above claim.



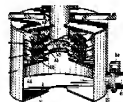
8. Claims 7-9, 11-13 and 15-17 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al as applied to claim 1 above, and further in view of Lemaire et al. (4,246,809).

Prior art (PA), i.e., Montgomery et al modified by Lemaire et al. as described in the previous Office action meets all of the limitations of the above claims. Regarding claim 11, PA meets all of the limitations, except for disclosing independent movement of the tongs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the tongs move independently and separate, depending on the application, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.



PA meets the limitations of claims 12, 13, 15 and 16, i.e., tong and back-up tong being displaceable vertically **18** and horizontally **7** on a chassis **20**; jacks not shown but acting on fingers 23 (Lemaire et al. 03:50-53) or weight compensation "cylinder" (Lemaire et al. 03:25-29) which may be displaced between the tongs to facilitate the positioning of the elements; winch **12**. Regarding claim 17, it is noted that, the invention as originally filed discloses that the structure is compact and suitable for building cleaning and lubricating equipment (paragraph 19), so it would have been obvious to provide the apparatus of PA with a cleaning and lubricating equipment for cleaning and lubrication the pipes as these equipments and their use are well known and common in the art.

**9.** Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over prior art as applied to claim 7 above, and further in view of Dyer (4,321,975).



Montgomery et al modified by Lemaire et al. as applied to claim 7, meets all of the limitations of the above claims, except for disclosing a bellows between the back up tong and the tong for collecting a content of the pipe. Providing a collecting device between the pips to collect mud or drilling fluid is known as evident by Dyer. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the modified invention of Montgomery et al and Lemaire et al. Using a bellows and placing it between the tong to collect the fluid in adapting the apparatus for a particular application is considered to be obvious to one of ordinary skill in the art as it would require routine experimentations with predictable results.

***Allowable Subject Matter***

10. Claim 4 is allowed.
11. The following is a statement of reasons for the indication of allowable subject matter: prior art considered alone or in combination does not provide teaching or suggestions for the cylinder and the piston to be double acting, wherein a plus side of the piston is in communication with a first passage in the swivel ring and a minus side of the piston is in communication with a second passage in the swivel ring, as recited in claim 4.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Response to Arguments***

13. Applicant's arguments filed August 12, 2008 have been fully considered but they are not persuasive. The arguments regarding KSR reasoning and that there is no

motive to combine and that Applicant's claims cannot be used as a blue print are acknowledged, but are not found persuasive. Claims do not recite sufficient structures to negate the KSR reasoning. As stated in the Office actions, making an element or a group of elements removable for ease of service, maintenance...is considered well within the knowledge of one of ordinary skill in the art. The modification as applied would only take routine experimentations with predictable results and Examiner is not applying hindsight reasoning, since the base reference meets all of the limitations as recited, except for the clamps to be removable from the ring.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 571-272-4495. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 3, 2008

/Hadi Shakeri/  
Primary Examiner, Art Unit 3727